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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/074,012	05/05/1998	SHIGEYOSHI YOSHIDA	0694-121	1497

7590 12/04/2002

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[REDACTED] EXAMINER

PIANALTO, BERNARD D

ART UNIT	PAPER NUMBER
1762	41

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/074,012	YOSHIDA ET AL. <i>OFF 41</i>
	Examiner	Art Unit
	Bernard D Pianalto	1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply *to this action as well as the action of 11-15-02*

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 04 November 2002.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 10-21 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 10-21 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) <input type="checkbox"/> Other: _____ .

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 10-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 10, last two lines "said electromagnetic interference suppressing body ... with said electronic device" is vague and indefinite. "An electronic device having attached thereto an electromagnetic interference suppression body ..." should be defined.

Claim Rejections - 35 USC § 102 35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 11, 15 and 17-21 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hartman for the same reasons as urged in the action of 11-15-02. Hartman's non electrically conductive iron particles having an electrically insulative coating such as alumina is encompassed by applicants' claimed particles. Half of the reference particles would be soft magnetic

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particles and applicants' claims do not exclude the coating and the other half would be electrically insulative particles and applicants' claims do not exclude the core. The alumina would be inherently heat conductive.

Claims 10 and 11 are further rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over either Goto et al or Horie for the same reasons as urged in the action of 11-15-02.

Claims 10-13 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Takahashi et al for the same reasons as urged in the action of 11-15-02.

Claim Rejections - 35 USC § 103

Claims 12, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman, Horie et al or Goto et al in view of Takahashi et al for the same reasons as urged in the action of 11-15-02.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman in view of either Ogawa et al or Takahashi et al for the same reasons as urged in the action of 11-15-02.

Response to Arguments

Applicant's arguments filed 11-4-02 have been fully considered but they are not persuasive. Applicants argue in the paragraph bridging pages 2 and 3 of their remarks that "These conductive paths of connected particles are the antithesis of an electrically insulating powder dispersed through the binder ... an electromagnetic wave would appear to be transmitted from one side to the other rather than being suppressed." The

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Examiner is not convinced by this argument since Hartman also discloses in col. 7, lines 50-65 a thermally conductive, electrically insulative tape. Applicants further argue in the first full paragraph on page 3 of their remarks that "But how can Hartman be made multiplayer without destroying the electrically conductive bridges?" See the above paragraph which argues that the Hartman disclosure is not limited to a conductive bridge. Applicants further argue in the same paragraph that "Ogawa and Takahashi are not electromagnetic interference suppression articles ... destroy the information recorded on the tape ... a material akin to a hard magnetic material ..." The examiner is not convinced by this argument since applicants' claims do not exclude the hard particles or what may be recorded. In further response to applicant's argument that the references are in the recording art, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Applicants further argue in the paragraph bridging pages 3 and 4 of their remarks that "Horie is only concerned with the dielectric properties and not with heat conductivity". The examiner is not convinced by this argument since the reference discloses the same materials used by applicants and the thermal conductivity would be inherent in the reference article. Applicants further argue in the first full paragraph on page 4 of their remarks that "the Goto reference

...the claims require a stationary article". The examiner is not convinced by this argument since the intended use of an article does not render an article claim patentable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernard D Pianalto whose telephone number is 703 308 2332. The examiner can normally be reached on 5:30-6:00 Mon-Wed.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on 703 308 2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9310 for regular communications and 703 872 9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 306 5665.

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**BERNARD PIANALTO
PRIMARY EXAMINER**